Practitioner's Docket No. 55,106 (1699)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Box Patent Application Assistant Commissioner for Patents Washington, D.C. 20231



NEW APPLICATION TRANSMITTAL

Transmitted herewith for filing is the patent application of

Inventor(s): Russell H. TAYLOR

Robert Charles SUSIL

WARNING:

37 CFR 1.41(a)(1) points out:

"(a) A patent is applied for in the name or names of the actual inventor or inventors.

(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in § 1.53(d)(4) and § 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless a petition under this paragraph accompanied by the fee set forth in § 1.17(i) is filed supplying or changing the name or names of the inventor or inventors."

For (title):

METHODS AND SYSTEMS FOR IMAGE-GUIDED SURGICAL **INTERVENSIONS**

CERTIFICATION UNDER 37 C.F.R. 1.10*

(Express Mail label number is mandatory.) (Express Mail certification is optional.)

I hereby certify that this correspondence and the documents referred to as attached therein are being deposited with the United States Postal Service on this date __September 18, 2000_, in an envelope as "Express Mail Post Office to Addressee," mailing Label Number EL196832898US addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

> Peter F. Corless (type of print name of person mailing paper)

signature of person mailing paper

WARNING:

Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.

*WARNING:

Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label

placed thereon prior to mailing. 37 C.F.R. 1.10(b).

"Since the filing of correspondence under \S 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442

(Application Transmittal—page 1 of 11)

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1. Type of Application

This new application is for a(n)

(check one applicable item below)

		[X]	Original (nonprovisional)				
		[]	Design				
		[]	Plant				
WARNIN		NG:	Do not use this transmittal for a completion in the U.S. of an International Application under 35 U.S.C. 371(c)(4), unless the International Application is being filed as a divisional, continuation or continuation-in-part application.				
	WARNI	NG:	Do not use this transmittal for the filing of a provisional application.				
TRA		TRANSA	the following 3 items apply, then complete and attach ADDED PAGES FOR NEW APPLICATION AITTAL WHERE BENEFIT OF A PRIOR U.S. APPLICATION CLAIMED and a NOTIFICATION IN PARENT ATION OF THE FILING OF THIS CONTINUATION APPLICATION.				
		[]	Divisional.				
		[]	Continuation.				
		[]	Continuation-in-part (C-I-P).				
	2.	Benefi	t of Prior U.S. Application(s) (35 U.S.C. 119(e), 120, or 121)				
	NOTE:	A nonpi	rovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional				

applications or copending international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or copending

international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first

paragraph of 35 U.S.C. 112. Each prior application must also be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

- (ii) Complete as set forth in § 1.51(b); or
- (iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or
- (iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(1) within the time period set forth in § 1.53(f).

37 CFR 1.78(a)(1).

NOTE If the new application being transmitted is a divisional, continuation or a continuation-in-part of a parent case, or where the parent case is an International Application which designated the U.S., or benefit of a prior provisional application is claimed, then check the following item and complete and attach ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

WARNING:

If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121 or 365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. 120, 121 or 365(c). (35 U.S.C. 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under 35 U.S.C. 119, 365(a) or 365(b).) For a c-i-p application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20,195, at 20,205.

WARNING:

When the last day of pendency of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, any nonprovisional application claiming benefit of the provisional application must be filed prior to the Saturday, Sunday, or Federal holiday within the District of Columbia. See 37 C.F.R. § 1.78(a)(3).

[] The new application being transmitted claims the benefit of prior U.S. application(s). Enclosed are ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

3. Papers Enclosed

A.	Required for Filing Date under 37 C.F.R. 1.53(b) (Regular) or 37 C.F.R. 1.153
	(Design) Application

 Pages of Specification	1			
 Pages of Claims				
 Sheets of Drawing				
[] Formal				
[] Informal				

B. Other Papers Enclosed

_	1	Pages	of Abstract
		Other	

WARNING:

DO NOT submit original drawings. A high quality copy of the drawings should be supplied when filing a patent application. The drawings that are submitted to the Office must be on strong, white, smooth, and non-shiny paper and meet the standards according to § 1.84. If corrections to the drawings are necessary, they should be made to the original drawing and a high-quality copy of the corrected original drawing then submitted to the Office. Only one copy is required or desired. For comments on proposed then-new 37 C.F.R. 1.84, see Notice of March 9, 1988... (1990 O.G. 57-62).

NOTE: "Identifying indicia, if provided, should include the application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call if the Office is unable to match the drawings to the proper application. This information should be placed on the back of each sheet of drawing a minimum distance of 1.5 cm. (5/8 inch) down from the top of the page." 37 C.F.R. 1.84(c)).

(complete the following, if applicable)

	[]	The enclosed drawing(s) are photograph(s), and there is also attached a "PETITION TO ACCEPT PHOTOGRAPH(S) AS DRAWING(S)." 37 C.F.R. 1.84(b).			
4.	Additi	ional Papers Enclosed			
	[] [] [] []	Preliminary Amendment Information Disclosure Statement (37 C.F.R. 1.98) Form PTO-1449 Citations Declaration of Biological Deposit Submission of "Sequence Listing," computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.			
	[] []	Authorization of Attorney(s) to Accept and Follow Instructions from Representative Special Comments Other:			
5.	Declai	ration or Oath			
NOTE:	A newly executed declaration is not required in a continuation or divisional application provided the prior nonprovisional application contained a declaration as required, the application being filed is by all or fewer than all the inventors named in the prior application, there is no new matter in the application being filed, and a copy of the executed declaration filed in the prior application (showing the signature or an indication thereon that it was signed) is submitted. The copy must be accompanied by a statement requesting deletion of the names of person(s) who are not inventors of the application being filed. If the declaration in the prior application was filed under § 1.47 then a copy of that declaration must be filed accompanied by a copy of the decision granting § 1.47 status or, if a nonsigning person under § 1.47 has subsequently joined in a prior application, then a copy of the subsequently executed declaration must be filed. See 37 CFR 1.63(d).				
NOTE: A declaration filed to complete an application must be executed, identify the specification to which it is directly each inventor by full name, including the family name, and at least one given name without abbreviat together with any other given name or initial, and the residence, post office address and country of citizensh inventor and state whether the inventor is a sole or joint inventor. 37 CFR 1.63(a)(1)-(4).					
	[]	Enclosed			
		Executed by (check all applicable boxes) [] inventor(s). [] legal representative of inventor(s). 37 CFR 1.42 or 1.43. [] joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached. [] This is the petition required by 37 CFR 1.47 and the statement required by 37 CFR 1.47 is also attached. See item 13 below for fee.			
	[X]	Not Enclosed.			

NOTE: Where the filing is a completion in the U.S. of an International Application, or where the completion of the U.S. application contains subject matter in addition to the International Application, the application may be treated as a continuation or continuation-in-part, as the case may be, utilizing ADDED PAGE FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION CLAIMED.

		[] Application is made by a person authorized under 37 C.F.R. 1.41(c) on behalf of all the above named inventor(s).				
	(The declaration or oath, along with the surcharge required by 37 CFR 1.16(e), can be filed subsequently).				
NOTE:	It is im	ortant that all the correct inventor(s) are named for filing under 37 CFR 1.41(c) and 1.53(b).				
		[] Showing that the filing is authorized. (not required unless called into question. 37 CFR 1.41(d))				
6.	Inver	torship Statement				
WARN	ING:	If the named inventors are each not the inventors of all the claims an explanation, including the ownership of the various claims at the time the last claimed invention was made, should be submitted.				
The in	ventors	ip for all the claims in this application are:				
	[]	The same.				
	[]	Not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made, [] is submitted. [] will be submitted.				
7.	Lang	age				
NOTE:	transla	ication including a signed oath or declaration may be filed in a language other than English. An English ion of the non-English language application and the processing fee of \$130.00 required by 37 CFR 1.17(k) is to be filed with the application, or within such time as may be set by the Office. 37 CFR 1.52(d).				
	[X] []	English Non-English [] The attached translation includes a statement that the translation is accurate. 37				
8.	Assig	C.F.R. 1.52(d).				
	[] An assignment of the invention to					
		is attached. A separate [X] "COVER SHEET FOR ASSIGNMENT (DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION" or [] FORM PTO 1595 is also attached.				
		[] was filed in the parent application[X] will follow.				

NOTE: "If an assignment is submitted with a new application, send two separate letters-one for the application and one for the assignment" Notice of May 4, 1990 (1114 O.G. 77-78).

WARNING:

A newly executed "STATEMENT UNDER 37 CFR 3.73(b)" must be filed when a continuation-in-part application is filed by an assignee. Notice of April 30, 1993, 1150 O.G. 62-64.

9. Certified Copy

Certified copy(ies) of application(s)

Country	Appln. No.	Filed

from which priority is claimed

_	٦.		•	
		10	enc	losed.
ı	- 1	13	CIIC	ioscu.

- [] was filed.
- [] will follow.

NOTE: The foreign application forming the basis for the claim for priority must be referred to in the oath or declaration. 37 CFR 1.55(a) and 1.63.

NOTE: This item is for any foreign priority for which the application being filed directly relates. If any parent U.S. application or International Application from which this application claims benefit under 35 U.S.C. 120 is itself entitled to priority from a prior foreign application, then complete item 18 on the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

10. Fee Calculation (37 C.F.R. 1.16)

A. [X] Regular application

CLAIMS AS FILED

Claims	Number Filed	Basic Fee Allowance	Number Extra	Rate	Basic Fee 37 C.F.R. 1.16(a) \$690.00
Total Claims (37 CFR 1.16(c))		- 20 =	0	x \$ 18.00	690.00
Independent Claims (37 CFR 1.16(b))		- 3 =	0	x \$78.00	
Multiple Dependent Claim(s), if any (37 CFR 1.16(d))			+	\$260.00	

ı	•	l Amend	lment cance	elling	extra c	laims is	enclosed	d.
ı		1 1110110	erricatic contro.		UZZUU U	TOTAL TO	01101000	

- [] Amendment deleting multiple-dependencies is enclosed.
- [] Fee for extra claims is not being paid at this time.

NOTE:		he fees for extra claims are not paid on filing they must be paid or the claims cancelled by amendment, prior to the iration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 CFR 5(d).					
				Filing Fee Calculation	\$		
	В.	[]	Design application (\$330.00—37 CFR	1.16(f))			
				Filing Fee Calculation	\$		
	C.	[]	Plant application (\$540.00—37 CFR	1.16(g))			
				Filing Fee Calculation	\$		
11.	Small	Entity S	Statement(s)				
	[]	Statem	• •	filing by a small entity und	der 37 CFR 1.9 and 1.27 is ((are)	
WARN	ING:	available or pater patent in division a reissu continui 121, or applicat the state or in the	le and desired. Status as a and including applications of method the status has been, or continuation-in-part (including or reissue application. Status as a statu	small entity in one application or por patents which are directly or income stablished. The refiling of an application a continued prosecution and the determination as to continued A nonprovisional application claimation, or a reissue application or the continued in the patent or includes a color or in the patent or includes a color.	,,,,	eation on or ation, ing of or the 120, prior ace to eation	
			, -	,			
	[]	Status on	as a small entity was o	claimed in prior application _ om which benefit is being cla		filed r:	
		35 U.S	[] 120 [] 121				
		and wh	hich status as a small e	entity is still proper and desir	red.		
		[]	A copy of the staten	nent in the prior application i	is included.		
	Filing Fee Calculation (50% of A, B or C above)						

 $[\]$

NOTE: Any excess of the full fee paid will be refunded if a small entity status is established refund request are filed within 2 months of the date of timely payment of a full fee. The two-month period is not extendable under § 1.136. 37 CFR 1.28(a).

12. Request for International-Type Search (37 C.F.R. 1.104(d)) (complete, if applicable) [] Please prepare an international-type search report for this application at the time when national examination on the merits takes place. 13. Fee Payment Being Made at This Time [X] Not Enclosed No filing fee is to be paid at this time. [X](This and the surcharge required by 37 C.F.R. 1.16(e) can be paid subsequently.) Enclosed [] Filing fee Recording assignment (\$40.00; 37 C.F.R. 1.21(h)) (See attached "COVER SHEET FOR ASSIGNMENT ACCOMPANYING NEW APPLICATION.") \$ [] Petition fee for filing by other than all the inventors or person on behalf of the inventor where inventor refused to sign or cannot be reached (\$130.00; 37 C.F.R. 1.47 and 1.17(i)) [] For processing an application with a specification in a non-English language (\$130.00; 37 C.F.R. 1.52(d) and 1.17(k)) Processing and retention fee (\$130.00; 37 C.F.R. 1.53(d) and 1.21(l))

NOTE: 37 CFR 1.21(1) establishes a fee for processing and retaining any application that is abandoned for failing to complete the application pursuant to 37 CFR 1.53(f) and this, as well as the changes to 37 CFR 1.53 and 1.78(a)(1), indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee must be paid, or the processing and retention fee of § 1.21(1) must be paid, within 1 year from notification under § 53(f).

Fee for international-type search report

(\$40.00; 37 C.F.R. 1.21(e))

Total	Fees	Enci	neer
LUIA	T.C.C.S	Lanc	111301

\$		

14.	Method of Payment of Fees				
	[Check in the amount of \$			
	[]	Charge Account No in the amount of \$ A duplicate of this transmittal is attached.			
NOTE:	Fees s	hould be itemized in such a manner that it is clear for which purpose the fees are paid. 37 CFR 1.22(b).			
15.	Auth	orization to Charge Additional Fees			
WARNI	ING:	If no fees are to be paid on filing, the following items should not be completed.			
WARNI	ING:	Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges, if extra claim charges are authorized.			
	[]	The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Account No			
paid or these claims cancelled notice of fee deficiency (37 CF		se additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any of fee deficiency (37 CFR 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except y when dealing with amendments after final action.			
		 [] 37 C.F.R. 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application) [] 37 CFR 1.17(a)(1)-(5) (extension fees pursuant to § 1.136(a). [] 37 C.F.R. 1.17 (application processing fees) 			
NOTE:	requirii extensio require reply re forth in	itten request may be submitted in an application that is an authorization to treat any concurrent or future reply, ng a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for on of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all d extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future equiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a for an extension of time under this paragraph for its timely submission." 37 CFR 1.136(a)(3).			
		[] 37 C.F.R. 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to			

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 CFR 1.311(b)).

37 C.F.R. 1.311(b))

NOTE: 37 CFR 1.28(b) requires "Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying, . . issue fee." From the wording of 37 CFR 1.28(b), (a)

notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

16. Instructions as to Overpayment

NOTE:	" Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 CFR 1.26(a).					
	[]	Credit Account No	04-1105			
	[]	Refund				
				SIGNATURE OF PRACTITIONER		
Reg. N	Io. 33,8	60		Peter F. Corless (type or print name of practitioner)		
				Dike, Bronstein, Roberts & Cushman Intellectual Property Practice		
Tel. N	o.: (617	7) 523-3400		EDWARDS & ANGELL, LLP 130 Water Street P.O. Address		
Custor	ner No.:	:		Boston, MA 02109		

[] Incorporation by reference of added pages

(check the following item if the application in this transmittal claims the benefit of prior U.S. application(s) (including an international application entering the U.S. stage as a continuation, divisional or C-I-P application) and complete and attach the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED)

LJ	Plus Added Pages for New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed				
	Number of pages added				
[]	Plus Added Pages for Papers Referred to in Item 4 Above				
	Number of pages added				
[]	Plus added pages deleting names of inventor(s) named on prior application(s) who is/are no				
	longer inventor(s) of the subject matter claimed in this application.				
	Number of pages added				
[]	Plus "Assignment Cover Letter Accompanying New Application"				
	Number of pages added				

[X] Statement Where No Further Pages Added

(if no further pages form a part of this Transmittal, then end this Transmittal with this page and check the following item)

[X] This transmittal ends with this page.